

REMARKS***Summary of the Response***

By the present response, claim 18 has been amended. Accordingly, claims 18 – 42 remain pending, of which claims 39 – 42 are withdrawn as being drawn to a non-elected invention. Reconsideration of the rejected claims in view of the above amendment and following remarks is respectfully requested.

Summary of the Office Action

In the instant Office Action, the Examiner has rejected claims 18 – 38 over the art of record. By the present amendment and remarks, Applicants submit that the rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Traversal of Rejection Under 35 U.S.C. § 102(b)

Applicants traverse the rejection of claims 18 – 23 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,413,371 issued to Ahonen et al. [hereinafter AHONEN]. The rejection is respectfully traversed.

Independent Claim 18

The present invention relates to a paper machine. Independent claim 18 recites, in pertinent part:

. . . a wire section;
a pressing section;
a drying section;
a coating color distribution chamber;

a film press having at least one film roll structured and arranged to apply a coating color supplied by the coating color distribution chamber;

To anticipate a claim, each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. MPEP § 2131.

Applicants submit AHONEN does not disclose all of the features of the claimed invention. For example, Applicants submit AHONEN at least does not disclose “a coating color distribution chamber” and “a film press having at least one film roll structured and arranged to apply a coating color supplied by the coating color distribution chamber,” as recited in claim 18.

AHONEN discloses a method for manufacture of paper and a paper machine to make paper suitable for color powder printing. However, while acknowledging AHONEN appears to disclose a coating section, Applicants respectfully submit this section is a film size press for applying a size, e.g., starch, not a coating color. More specifically, AHONEN discloses at column 5, lines 5 – 8 that (emphasis added):

[a]fter the forward dryer section 400, there is a film size press 500, which is followed by an after-dryer 600 consisting of dryer groups R_{j1} , R_{j2} that apply single-wire draw, as well as a shoe calender 700 and a reel-up 800.

As is readily understood by those of ordinary skill in the art of paper making, sizing or size is a substance that is applied to materials as a protecting glaze, filler, or lubricant. Size is used to change surface properties in papermaking. More specifically, size is used on fibers during paper manufacture in order to curb their tendency to absorb liquids by capillary action. By doing so, sizing keeps the ink on the surface of the paper where it was intended to remain. In addition, sizing may affect abrasiveness, creasibility, finish, printability, smoothness, and surface bond strength and decreases surface porosity and fuzzing.

No Disclosure of Coating Color Distribution Chamber

In view of the above, Applicants submit that AHONEN does not disclose a coating color distribution chamber. That is, as AHONEN does not disclose applying a coating color, Applicants submit that AHONEN does not disclose a coating color distribution chamber, as recited in claim 18.

As such, Applicants submit that AHONEN does not disclose each of the features of claim 18, and does not anticipate the present invention.

No Disclosure of a Film Press Having At Least One Film Roll Structured and Arranged to Apply a Coating Color Supplied by the Coating Color Distribution Chamber

Additionally, Applicants submit AHONEN does not disclose a film press having at least one film roll structured and arranged to apply a coating color supplied by the coating color distribution chamber. That is, Applicants submit that the size film press of AHONEN is expressly disclosed as a size press, and there is no express or implied disclosure of a press structured and arranged to apply a coating color supplied by the coating color distribution chamber. Rather, as discussed above, the size film press of AHONEN is operable to apply a size to a paper web. That is, as AHONEN is directed to making paper suitable for color powder printing (i.e., by a downstream user of the paper), Applicants submit there is no disclosure of a coating color being applied or even contemplated during the paper making process of AHONEN. As such, Applicants submit AHONEN fails to disclose a film press having at least one film roll structured and arranged to apply a coating color supplied by the coating color distribution chamber, as recited in claim 18.

Accordingly, for at least these reasons, Applicants submit that AHONEN does not disclose each of the features of claim 18, and does not anticipate the present invention.

Dependent Claims 19 – 23

Applicants respectfully submit that claims 19 – 23 depend from an allowable independent claim, and are allowable based upon the allowability of the independent claim, and because these claims recite additional subject matter to further define the instant invention.

Claim 22

Additionally, Applicants submit that AHONEN does not disclose the features of claim 22.

Claim 22 recites, in pertinent part:

. . . a float dryer arranged between the film press and the calender.

In addressing claim 22, the Examiner states “impingement dryer 450 reads on a float dryer with hot air.” Applicants disagree.

Initially, Applicants submit that the Examiner has not addressed each of the features of claim 22 as recited. That is, the Examiner fails to address how he has interpreted the dryer 450 of AHONEN to be “arranged between the film press and the calender.” As such, as discussed further below, Applicants respectfully submit that the Examiner has not presented a complete action or a clear record.

Moreover, Applicants submit that a careful review of AHONEN’s figures reveal the impingement dryer 450 is not arranged between the film press and the calender. Rather, as shown in Figure 1, the impingement dryer 450 is arranged upstream of both the film press and the calender. As such, Applicants submit AHONEN does not disclose each of the features of claim 22, and does not anticipate the present invention.

Claim 23

While the Examiner has indicated that claim 23 is anticipated by AHONEN, Applicants submit that the Examiner never specifically addressed the features of claim 23. Claim 23 recites, in pertinent part:

. . . the float dryer comprises a thermal radiation generator.

However, Applicants submit the Examiner has not positively identified the recited structure in the applied art. As such, as discussed further below, Applicants respectfully submit that the Examiner has not presented a complete action or a clear record.

Accordingly, for at least the above reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 18 – 23 under 35 U.S.C. § 102(b) and indicate that claims 18 – 23 are allowable.

Traversal of Rejections Under 35 U.S.C. § 103(a)

Dependent Claims 24, 25 and 28 – 38 over AHONEN

Applicants traverse the rejection of claims 24, 25 and 28 – 38 under 35 U.S.C. § 103(a) as being unpatentable over AHONEN. The rejection is respectfully traversed. Applicants submit AHONEN does not teach or suggest each of the features of the instant invention.

Applicant respectfully submits that claims 24, 25 and 28 – 38 depend from an allowable independent claim, and are allowable based upon the allowability of the independent claim as explained above, and because these claims recite additional subject matter to further define the instant invention.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. See MPEP §2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.¹ Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 28

Applicants submit that AHONEN does not teach or suggest the features of claim 28.

Claim 28 recites, in pertinent part:

. . . the film press is structured and arranged to operate with a coating color having a binder system comprising starch.

In addressing claim 28, the Examiner states, “[AHONEN] disclose coating color,” but he has not provided any specific authority in AHONEN to support his allegation. Thus, Applicants

¹ While the *KSR* court rejected a rigid application of the teaching, suggestion, or motivation (“TSM”) test in an obviousness inquiry, the [Supreme] Court acknowledged the importance of identifying “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” in an obviousness determination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007)).

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respectfully disagree with the Examiner and request some supporting evidence if this rejection is to be maintained.

Moreover, for the reasons discussed above with regard to claim 18, Applicants submit AHONEN does not disclose a coating color. That is, Applicants submit that there is no disclosure that the film size press of AHONEN is structured and arranged to apply a coating color supplied by a coating color distribution chamber, nor is there any discernable suggestion by AHONEN to apply a coating color in lieu of an in addition to the size. Thus, as discussed above, the size film press of AHONEN is disclosed only as operable to apply a size to a paper web.

Thus, for at least these reasons, Applicants submit that AHONEN does not teach or suggest the features of claim 28, and does not render the present invention unpatentable.

Applicants respectfully request that, should the Examiner maintain his position that AHONEN discloses a coating color, that he specifically identify where he believes AHONEN discloses this feature.

Claims 31 – 35

While the Examiner indicated that claims 31 – 35 were rejected as obvious over AHONEN, Applicants submit that the Examiner never addressed any of the features of these claims. As such, as discussed further below, Applicants respectfully submit that the Examiner has not presented a complete action or a clear record.

Moreover, Applicants submit that AHONEN does not teach or suggest the features of claims 31 – 35. Claims 31 – 35 recite features of a metering rod, but the Examiner has not identified any structure described in AHONEN that would be construed by one ordinarily skilled

in the art as a metering rod. Thus, Applicants submit that AHONEN does not teach or suggest the features of claims 31 – 35, and does not render the present invention unpatentable.

Claim 36

Applicants submit that AHONEN does not teach or suggest the features of claim 36.

Claim 36 recites, in pertinent part:

. . . the at least one film roll has a diameter of more than 1500 mm.

In addressing claim 36, the Examiner states, “[i]t would have been obvious that the film roll be structured to be of a diameter that would provide for process and product results.”

Initially, Applicants respectfully submit that the Examiner has not properly addressed the features of claim 36. As such, as discussed further below, Applicants respectfully submit that the Examiner has not presented a complete action or a clear record.

Moreover, Applicants submit that AHONEN does not teach or suggest the at least one film roll has a diameter of more than 1500 mm. In fact, Applicants submit that AHONEN is completely silent as to the dimensions of the film rolls of the film size press section. Thus, Applicants submit that AHONEN does not teach or suggest the features of claim 36, and does not render the present invention unpatentable.

Accordingly, for at least these reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 24, 25 and 28 – 38 under 35 U.S.C. § 103(a) and indicate that claims 24, 25 and 28 – 38 are allowable.

Dependent Claims 26 and 27 over AHONEN in view of MESCHENMOSER

Applicants traverse the rejection of claims 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over AHONEN in view of U.S. Patent 6,406,596 issued to Meschenmoser [hereinafter MESCHENMOSER]. The rejection is respectfully traversed. Applicants submit AHONEN in view of MESCHENMOSER fails to teach or suggest each of the features of the instant invention.

Applicant respectfully submits that claims 26 and 27 depend from an allowable independent claim, and are allowable based upon the allowability of the independent claim as explained above, and because these claims recite additional subject matter to further define the instant invention.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 26 and 27 under 35 U.S.C. § 103(a) and indicate that claims 26 and 27 are allowable.

Complete Action Not Provided

Applicants respectfully submit that the Examiner did not provide a complete action, and as such, Applicants submit that the next action should not be a final action. As set forth above, Applicants submit that with regard to claims 23 and 31 – 35, the Examiner has not addressed any of the features of these claims, and with regard to claims 22 and 36, the Examiner has not properly addressed each of the features as recited.

Thus, Applicants submit that a clear record was not provided and a clear issue was not developed between Applicants and the Examiner. More specifically, MPEP §706 states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as

speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.

Additionally, MPEP 706.07(a) notes:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Accordingly, Applicants respectfully request that the Examiner properly address the features of claims 22, 23 and 31 – 36, such that a clear issue is developed between the Examiner and Applicants. Moreover, Applicants respectfully submit that the next action, which should clarify the record, cannot be a final action.

CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious Applicants' invention, as recited in claims 18 - 38. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all of the claims therein are respectfully requested and now believed to be appropriate.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Authorization is hereby given to charge any fees necessary for the consideration of this amendment to deposit account No. 19-0089.

Respectfully submitted,
Ulrich BEGEMANN et al.



Neil F. Greenblum
Reg. No. 28,394

Robert W. Mueller
Reg. No. 35,043

GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191